

Appl. No. 09/746,611
Office Action mailed May 4, 2005
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Attorney Docket No. 10022/24

REMARKS

1. Claims 1, 3-4, 7-8, 12-18, 22-26 and 28-48 are pending in the application. The Examiner is thanked for withdrawing previous rejections under 35 U.S.C. § 102(e) and § 103(a). Claims 1, 3-4, 7-8, 12-18, 22-26, 28-48 are presently rejected as unpatentable under 35 U.S.C. § 103(a) in view of two non-patent references, an article, "Public Private Partnership," published in May, 1999, and a proposal evaluation tool, "FedSelect," dated September, 1999. Independent Claims 1, 18, and 32 have been amended.

2. The Examiner is thanked for the courtesy extended in granting an interview with the undersigned on July 13, 2005. The Examiner and SPE Tariq Hafiz were present, as well as the undersigned, Marc Richards from the Brinks Hofer Gilson & Lione law firm, and John Rollins, in-house patent attorney for the assignee. The references and Claim 1 were discussed. The Examiner advised that the claims might be allowable if they were expanded to include how the rankings or evaluations were performed. Agreement was not reached on allowability of the claims.

3. The Office Action states that "Public Private Partnership" discloses most of the limitations of the claims, and admits that Public Private Partnership does not expressly disclose evaluating the information by computer. Office Action, p. 4, lines 1-2. The Office Action further states that pp. 3-4 of "FedSelect" disclose a software tool that allows users to evaluate proposals using a computer, thus making the process more efficient. Applicants traverse the rejections, because the references do not teach or suggest all the limitations of the claimed inventions.

Claim 1

The Office Action states that Public Private Partnership (PPP) discloses all the limitations of Claim 1 for evaluating a proposal except for the step of "evaluating the gathered information by computer." The Office Action cites PPP, p. 6 (last paragraph),

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Fig. 2.1 (pp. 7-10), pp. 67-68, and pp. 70-72, for the step of gathering information relevant to the proposal, wherein the proposal includes at least two alternative structures (emphasis added). The PPP article does not teach or suggest that a private partner (or that the public entity) will propose more than one proposal. For example, PPP states that for any project, the Request for Proposal (RFP) proposed by the local government will include the basic conditions expected in the resulting partnership, such as preferred length (duration) of the partnership, ownership of assets during and after the partnership, and so forth. PPP, p. 53. This strongly suggests that a single structure is envisioned in the RFP proposal by the public entity, and does not teach or suggest that a bidder or private partner will propose more than one proposal or structure.

This section also states that certain of these conditions desired in the RFP may be subject to negotiations with the preferred partner(s). PPP, p. 54. There is no suggestion or teaching that the possible partner(s) would construct more than a single proposal or more than one structure for the proposal. Accordingly, at least this limitation of Claim 1 is not taught or suggested in the Public Private Partnership article. Nevertheless, Claim 1 has been amended to recite that the structures are ranked by costs, a rate of return, an assessment of potential future benefits, and a revenue stream. Support for the amendment is found at least in the specification at p. 18, lines 1-12. The Examiner is respectfully requested to withdraw the rejection of Claim 1.

Claim 3

The rejection states that FedSelect teaches the Claim 3 limitation wherein the information gathering step comprises answering predetermined questions on at least one template stored in a computer and the answers to at least one predetermined question call up at least one more template of predetermined questions, and the computer uses answers to said questions to evaluate the proposal. The rejection cites p. 3 of FedSelect, which states, "FedSelect guides evaluators through an organized set of online forms to enter/record clarification requests, deficiency

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reports, ratings, rationale, and impact statements." Evaluators' comments are stored for later review. Public Private Partnership, p. 3.

This passage does not teach the Claim 3 limitation that the answer to at least one predetermined question calls up at least one more template of predetermined questions. Furthermore, in Claim 3, the templates are used in an early stage of the evaluation process, the information gathering stage, whereas in the FedSelect reference, the information has already been gathered and the "on-line" forms are used in a step of evaluating information by computer, rather than gathering information. Accordingly, FedSelect does not teach or suggest the limitations of Claim 3, which is therefore allowable.

Claim 4

The rejection states that the limitations of Claim 4 are disclosed in Public Private Partnership, at p. 44 and at p. 71, because PPP "discloses considerations of revenue, cost, ROI, etc., when evaluating the proposals." Office Action, p. 5, lines 10-14.

Costs are mentioned on p. 44 in the context of a cost/benefit analysis. On p. 71, financial considerations are mentioned as part of "Submission Requirements," which begins on p. 69. The portion on p. 71 states that potential partners are expected to submit a financial plan, including their definition of "an acceptable rate of return," and the expected return to the proposed private sector partner. There is no mention here of evaluating the proposal by "an acceptable rate of return" or by at least one of the financial measures recited in Claim 4.

Instead of basing the evaluation on financial considerations, PPP teaches the fifteen evaluation criteria listed on p. 74. These criteria include "the proposed solution to the needs of the local government," and "financial stability of the potential partner." None of the fifteen is a financial criterion such as those recited in Claim 4, a revenue stream, a return on average assets, a return on investment, a return on equity, an internal rate of return, and a net present value.

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Public Private Partnership thus teaches against the invention of Claim 4, because Public Private Partnership teaches evaluation criteria using considerations more important than the financial criteria that would be important to a private partner. The reference does not teach or suggest the limitations of Claim 4 and thus the Office Action fails to make out a prima facie case of obviousness against Claim 4.

Claims 7, 12, 13, and 15-17

The rejection admits that Public Private Partnership does not disclose the limitations of Claim 1 or Claims 7, 12, 13, and 15-17, but that "FedSelect" does disclose the limitations of these claims on p. 3. Claims 7, 12, 13 and 15-17 are allowable at least because they depend from Claim 1, or from claims depending from Claim 1.

Claim 14

Claim 14 is rejected over "Public Private Partnership," the rejection stating that the limitations of Claim 14 are taught in p. 2, Fig. 2.1 (beginning on p. 7), and p. 71, and alleging that these pages disclose establishing partnerships to deliver a service. Claim 14 recites the method of Claim 1, wherein the proposal comprises an offer of a service from a provider that comprises a step of calculating a way to pay for the proposal.

Applicants traverse the rejection of Claim 14. The cited pages discuss evaluating public private proposals (p. 2), the types of public private proposals (Table 2.1, pp 7-10), and the requirement for a business plan and a financial plan (pp. 70-71). These pages of "Public Private Partnership," however, do not teach or suggest that a proposal include a step of "calculating a way to pay for the proposal," as recited in Claim 14 and as discussed in the specification (pp. 4 and 17). Accordingly, the rejection of Claim 14 is improper, because the reference does not teach or suggest the limitations of Claim 14. The Examiner is respectfully requested to withdraw the rejection of Claim 14.

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Claims 18, 22-26, 28-36, and 38

Claims 18, 22-26, 28-36, and 38 are rejected on the same grounds as above Claims 1, 3, 4, 7 and 12-17. The rejection of Claims 18, 22-26, 28, 29, 32, 35, 36, and 38 is traversed. In addition, Claims 30-31 and 33-34 are allowable at least because they depend from allowable Claims 1 and 32, or from claims depending from allowable Claims 1 and 32.

Independent Claims 18 and 32 are allowable for the same reasons that Claim 1 is allowable. The references do not teach or suggest many of the limitations of Claims 18 and 32, including proposing a plurality of alternative structures for a proposal, and calculating an advantages for the structures of the proposal. For the same reasons mentioned above for Claim 1, the rejection of Claims 18 and 32 is improper. Claims 18 and 32 are allowable, as are the claims depending from them. The Examiner is respectfully requested to withdraw the rejection of Claims 18 and 32. In addition, Claims 22-26, 28, 29, 35-36, and 38 include additional limitations not taught in the references.

Nevertheless, Claims 18 and 32 have been amended to recite additional limitations concerning the method of evaluating the alternative structures. Support for the amendments is found at least in the specification at p. 18, lines 1-12. The Examiner is respectfully requested to withdraw the rejections of Claims 18 and 32.

a. Claim 22

The rejection of Claim 22 is traversed because the references do not teach or suggest, and the rejection does cite the references for, a step of entering information concerning the strength of a business relationship, and then calculating an advantage of the proposed structures based on the strength of the business relationship. Claim 22 is therefore allowable.

b. Claim 23-26 and 35-36

Claims 23-26 and 35-36 are similar to Claims 3-4 above, and their rejection is traversed for the same reasons, that the references do not teach or suggest a template

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of questions, or that the answer to a question will call up a second template with additional questions. In addition, as discussed above with respect to Claim 4, the references do not teach or suggest calculating an advantage of the proposal in financial terms, as recited in Claims 25-26 and 35-36.

c. Claim 28

The rejection of Claim 28 is traversed. The limitation of re-calculating the advantage of at least two alternative structures for the business proposal is not found in the references, and the rejection does not point to any such teaching in the rejection. Accordingly, the rejection of Claim 28 is improper. Claim 28 is therefore allowable.

d. Claim 29

The rejection of Claim 29 is also traversed. The limitations of searching the Internet, updating the search, and again recalculating the advantages of the proposals is not cited in the rejection. The rejection of Claim 29 is improper, and Claim 29 is therefore allowable.

e. Claim 38

The rejection of 38 is similarly improper. The rejection cites no passage in either reference for the particular limitation of Claim 38, wherein the computer uses a C-A-R (control-action-response) technique for seeking and inputting information from a user into the computer. The rejection of Claim 38 is improper, and Claim 38 is allowable.

Claims 39-48

Claims 39-48 are allowable at least because they depend from allowable Claims 1, 18, and 32. In addition, several of these claims are also allowable because they recite additional limitations that are not found in the cited references.

a. Claims 40 and 47

The rejection of Claims 40 and 40 is traversed. The references cited in the rejection, Public Private Partnership, does discuss assets in the context of distribution of asset when the partnership is dissolved, on p. 94. However, there is no teaching that

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the asset was created as a result of the formation of the partnership (emphasis added). The asset might have already been in existence, perhaps as an asset (e.g., a building) of the private party or the public party, as also stated on p. 94. The reference does not teach or suggest that creation of the asset was included in the structure of at least one of the proposals. The rejection of Claims 40 and 47 is overcome, and the Examiner is requested to withdraw the rejection of Claims 40 and 47.

b. Claim 41

The rejection of Claim 41 is also traversed. Claim 41 recites a limitation that the provider furnishes information to the purchaser demonstrating a difference in value to the purchaser based on the alternative structures. The rejection cites pp. 45, 54, 71, and 72, which discuss risk and value, but do not teach or suggest a difference in value based on [two] alternative structures as claimed (emphasis added). Since the reference does not teach or suggest all the limitations of Claim 40, the rejection is overcome and Claim 40 is allowable.

c. Claims 42 and 48

Claims 42 and 48 recite further limitations wherein at least one of cost drivers and revenue drivers is used to evaluate and rank the structures. The rejection cites pp. 71 and 80 of Public Private Partnership as teaching this limitation. Applicants traverse the rejections. The cited reference teaches project management and mentions control of costs during the project, but there is no mention of "cost drivers" and "revenue drivers" as information that may be used to evaluate and rank structures for a proposal. The reference does not teach or suggest all the limitations of Claims 40 and 42. The rejection is overcome and Claims 40 and 42 are therefore allowable.

d. Claims 43, 44 and 45

Claims 43, 44 and 45 are rejected over pp. 44 and 71, and Fig. 2.1 (beginning on p. 7) of Public Private Partnership. These dependent claims recite a method in which the value or the advantages of the proposed structure are calculated as a revenue

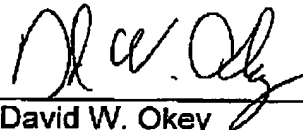
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stream to the purchaser, or by a financial criterion other than a revenue stream. The pages cited teach forms of public private partnerships (Fig. 2.1), costs and benefits of a public private partnership (p. 44), and project management (p. 71). However, these pages do not teach specific forms of calculation of a financial benefit as a result of a project, or as a way to evaluate a structure of a proposal. These pages also do not teach or suggest evaluating two structures of a proposal using these financial tools. The reference does not teach or suggest all the limitations of Claims 43, 44 and 45. The rejection is overcome and Claims 43, 44, and 45 are therefore allowable.

4. Applicants have shown that Claims 1, 3-4, 7-8, 12-18, 22-26, 28-48 are not obvious over the prior art. Nevertheless, Applicants have amended the independent claims of the present application, Claims 1, 18, and 32, to expedite prosecution and in accordance with the suggestion of the Examiner at the interview. Applicants respectfully request the Examiner to withdraw the rejections and to allow the claims of the application.

Respectfully submitted,

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